

d.) Remarks:

In the Office Action, restriction is deemed required, under 35 U.S.C. § 121, to one of the following groups of claims:

Group I: Claims 1-10, drawn to a soluble composition extracted from a plant material (class 424, subclass 769); and

Group II: Claims 11-14, drawn to a soluble composition extracted from a plant material (class 424, subclass 769).

Applicant provisionally elects Group I, claims 1-10, with traverse. Further, Applicant provisionally elects the species carotenoids, anthocyanins, and alkaloids from Group I.

Remarks Regarding Restriction

As recited under M.P.E.P. § 803, restriction is appropriate only when the groups can be shown to be distinct and there would be a "serious burden" placed on the Examiner to examine more than one group of claims. No such distinction or serious burden has been established and Applicant respectfully requests that this restriction be withdrawn.

According to the restriction, Groups I and II are directed to related products and refers to MPEP § 806.05(j). However, the restriction does not satisfy the requirements set forth in MPEP § 806.05(j) which states that **both** two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status in the art, or field of search. The Office Action fails to show two-way distinctness or a reason that the restriction is necessary. The groups are in the same class and the *same subclass*, have the same status in the art, and are in the same field of search.

The Office Action states that the groups require a different field of search according to MPEP § 808.02. However, the reasoning that "the search is not co-extensive particularly with regard to the literature search" does not satisfy the criteria stated in MPEP § 808.02. A different field of search exists when there is searching of different classes/subclasses or electronic resources, or employment of different search queries. Groups I and II can be searched in either

EAST or WEST with the same search query. For example, the search can be narrowed to within 424/769, and then further to include the desired substances. Electronic word search queries producing patents with highlighted terms provides an efficient and convenient means for examining prior art. Searching for one or all of the substances or a combination of multiple substances within the scope of the invention is not unduly burdensome.

The Office Action further states as reasoning that a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious the invention of the other group. This reason for restriction is not necessary, nor consistent with MPEP § 808.02. Finally, the Office Action states that consideration for patentability is different in each case. Again, this reasoning is not necessary, nor consistent with MPEP § 808.02. Thus, the restriction requirement is incorrect and unnecessary.

A restriction requirement is imposed "only" when it would be a serious burden on the examiner to examine all of the claims at once. No burden exists in this instance. Both groups have been placed in the same class and the *same subclass* by the Examiner. Thus, the burden to impose the restriction has not been met and remains with the USPTO. Withdrawal of the restriction and examination of all claim groups is respectfully requested.

Remarks Regarding Species Restriction

The Office Action alleges that the application contains claims directed to patentably distinct species and therefore, is subject to a species restriction. Applicant respectfully disagrees. In order to require a species restriction, it must be shown that the species fall within the scope of a generic claim, or that the species are independent or distinct, see MPEP § 806.04. As the Office Action stated, there are no generic claims (see page 4).

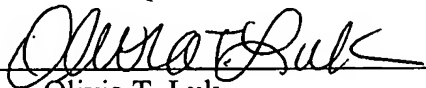
Under MPEP § 806.04(f), to require a restriction between claims limited to species, it must be shown that the claims do not overlap in scope. The Office Action fails to do so. All of claims 1-14 are directed to a soluble composition extracted from a plant material and all of claims 1-14 are in class 424, subclass 769. Thus, the Office Action has failed to establish a serious on the examiner under MPEP § 808.02 and both the restriction and species restriction should be withdrawn.

Conclusion

The application is in condition for examination and the prompt issuance of an Office Action is respectfully requested. If there are any additional fees due with the filing of this Response, including any additional fees for a further extension of time, not herein accounted for, applicant respectfully requests that extension and also requests that any and **all fees due be charged to Deposit Account No. 14-1437, referencing Attorney Docket No. 144006.00400.**

Respectfully submitted,

Date: April 13, 2006

By 
Olivia T. Luk
Registration No. 57,730

Novak Druce & Quigg LLP
1300 Eye Street, NW
400 East Tower
Washington, DC 20005
(202) 659-0100 (telephone)
(202) 659-0105 (fax)